

REMARKS

This Amendment is in response to the Office action dated January 22, 2010. A petition for appropriate extension of time and fee are submitted with this Amendment.

Rejection of Claim 4 Under 35 U.S.C. §102

The Examiner rejected claim 4 as being anticipated under 35 USC §102 by US Patent No. 5,209,691 to Eckstein ("Eckstein"). Applicant traverses the rejection.

The MPEP states,

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. V. Union Oil Co. of California*, 814 F.2d 628, 631 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987).

MPEP § 2131.

Eckstein does not disclose each and every element of claim 4. For example, Eckstein does not disclose a plurality of compressible pneumatic targets extending through an opening in the cover of a punching bag such that a first half of each compressible pneumatic target is exposed on the outside of the punching bag cover and the second half of the target is on the inside of the punching bag cover whereby the first and second halves of the compressible pneumatic targets are compressed from by a strike from the user. In fact, none of the references disclose this arrangement.

Applicant respectfully points out that the Examiner misinterpreted the original "means" clause by taking the position that such a "means" is boxing gloves and that the addition of this element to the claim added new matter. The claim element was written

App. No. 10/790,300
DN: BOOK 9341US

in a “means plus function” format under 35 U.S.C. §112 ¶6. The means for actuating the whistle corresponds to the disclosed structure that performs the function, e.g. the targets plus air conduits connected to the whistle. In any event, Applicant has amended claim 4 to remove the “means for” language.

Since Eckstein fails to disclose each and every element of claim 4, particularly as amended, Applicant respectfully submits that claim 4 is not anticipated and Applicant requests that Examiner withdraw the rejection of claim 4 under 35 U.S.C. §102(b).

Rejection of Claim 5 Under 35 U.S.C. §103

The Examiner rejected claim 5 as being obvious over Eckstein in view of Rubin Patent No. 5,741,970 (“Rubin”), Neuberger U.S. Patent No. 4,440,400 (“Neuberger”) or Critelli U.S. Patent No. 4,527,796 (“Critelli”). Applicant respectfully traverses the Examiner’s rejection of those Claims under 35 U.S.C. § 103.

Specifically, Applicant believes the Examiner cannot established a *prima facie* case of obviousness of claim 5, particularly as amended, as required under patent law and in accordance with the Manual of Patent Examining Procedure (“MPEP”). The MPEP states:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all of the claim limitations. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed., Cir 1991) See MPEP § 2143 - § 2143.03 for decisions pertinent to each of these criteria.

MPEP § 706.02(j) (emphasis added).

The combination of references does not teach or suggest all the elements of claim 5. By way of example, the cited references, either alone or in combination do not teach or suggest at least one compressible pneumatic target fixed in an opening in the punching bag cover such that a portion of the compressible pneumatic target is exposed on the cover of the punching bag and another portion of the target is on the inside of the cover with means for fixing the compressible pneumatic target in the opening in the punching bag cover. The "means for fixing", which is a means plus function element under 35 U.S.C. §112 ¶6, is disclosed at several places in the specification. For example, in Figs. 4, 6 and 7. None of the references, nor the combination of references, teaches or suggests this arrangement. Consequently, the references do not render claim 5 obvious and the claim is allowable.

New Claims 6-10

New claims 6 through 9 depend from independent claim 4 and further define the invention. Claim 6 is directed to the placement of the targets and is supported by Fig. 3. Claims 7-9 further define the configuration and attachment of the compressible pneumatic targets and are supported by the specification at pp. 7,8 and Figs. 4,6 and 7. In any event, none of the references disclose, teach or suggest the subject matter of claims 6-9 and the claims are allowable.

New claim 10 is an independent claim that embodies most of the patentable elements discussed above which are not disclosed, taught or suggested by the art of record. Therefore, Applicant believes that new claim 10 also is allowable.

App. No. 10/790,300
DN: BOOK 9341US

Conclusion

Applicant believes the above analysis made herein overcomes all of the Examiner's objections and rejections and that claims 4-10 are in condition for allowance. The Applicant urges the Examiner to issue a timely Notice of Allowance for those claims.

The Commissioner is hereby authorized to charge any additional fees or credit overpayment under 37 CFR 1.16 and 1.17, which may be required by this paper to Deposit Account 162201.

Respectfully submitted,

Date: July 21, 2010

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